



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,654	10/25/2001	Jens Erik Sorensen	52-162	7276

22653 7590 11/25/2005

EDWARD W CALLAN  
NO. 705 PMB 452  
3830 VALLEY CENTRE DRIVE  
SAN DIEGO, CA 92130

EXAMINER

PARDO, THUY N

ART UNIT PAPER NUMBER

2165

DATE MAILED: 11/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

RECEIVED  
OIP/IA/P  
DEC 05 2005

<b>Office Action Summary</b>	<b>Application No.</b> 09/980,654	<b>Applicant(s)</b> SORENSEN ET AL.	
	<b>Examiner</b> Thuy Pardo	<b>Art Unit</b> 2165	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 35,39,40,42-44,47,83,84 and 95-142 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 35,39,40,42-44,47,83,84 and 95-142 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/22/05</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Applicant's Amendment filed on August 22, 2005 in response to Examiner's Office Action has been reviewed. Claims 1-34, 36-38, 41, 45, 46, 48-82, 85-94 have been canceled, claims 35, 39, 42-44, 47, 83, 84 have been amended, and claims 95-142 have been added.
2. Claims 35, 39, 40, 42-44, 47, 83, 84 and 95-142 are presented for examination.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 35, 39, 40, 42-44, 47, 83, 84 and 95-142 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uchio et al. (Hereinafter "Uchio") US Patent Application No. US 2002/0019836 in view of Kossovsky et al. (Hereinafter "Kossovsky" US Patent Application No. US 2002/0002523.

As to claim 95, Uchio and Kossovsky teach the invention substantially as claimed as specified in previous action. Ucho further teaches receiving ideas for prospectively patentable inventions by on-line communications from contributors of said ideas, wherein said contributed

Art Unit: 2165

ideas include problems or needs to be solved by inventions [0216-0220 of page 11; 0069 of page 3; 0059 of pages 2-3; fig. 19]; accumulating said ideas in a computer database [ab; S1903 of fig. 19; 0088-0089]. Kossovsky further teaches utilizing a computer system to effect transfers of property rights to inventions derived at least in part from said accumulated ideas that include said problems or needs respectively contributed by said contributors, wherein said transfers are to transferees other than said contributors whom respectively contributed said problem or needs [transfer IP licence from seller to buyer, 450 of fig. 4; 0075; fig. 5B, 10-12, 17C, 19-21; 0121];

selling at least some right under the patent rights to at least some of said derived inventions [310-360 of fig. 3; 0051-0053]; and

providing economic gain of stock, bonds, cash or rights to a portion of anticipated income derived from said property rights to said contributors of said problems or needs [Highest bid for US Patent 5462750 is \$190,000, see fig. 12-13, 20-21; buying and selling IP rights, 0056, 0057].

As to claims 105, 107, 125 and 138, all limitations of these claims have been addressed in the analysis above, and these claims are rejected on that basis.

As to claim 35, Uchio and Kossovsky teach the invention substantially as claimed. Kossovsky further teaches systematically entering into said database ideas contributed for entry into said database without requiring any contributor of said ideas to have subject matter expertise as a prerequisite for entry of said contributions [IP listed on the exchange in database, 0043 of page 2].

As to claim 39, Uchio and Kossovsky teach the invention substantially as claimed. Uchio further teaches requiring persons to enter into a membership as a prerequisite for viewing a portion of said database containing at least some of said accumulated ideas [0169 of page 9].

As to claim 40, Uchio and Kossovsky teach the invention substantially as claimed. Uchio further teaches requiring contributors of ideas for prospective entry into said database to enter into a membership as a prerequisite for contributing ideas for entry into said database [0147 of page 7].

As to claim 42, Uchio and Kossovsky teach the invention substantially as claimed. Kossovsky further teaches auctioning at least some right under the patent rights to at least some inventions derived at least in part from said accumulated ideas [ab; fig. 3-5].

As to claim 43, Uchio and Kossovsky teach the invention substantially as claimed. Uchio further teaches recording a time of receipt of each idea contributed for entry into said database [0089 of page 4].

As to claim 44, Uchio and Kossovsky teach the invention substantially as claimed. Uchio further teaches recording a time of publication in said database of each accumulated idea [fig. 30].

Art Unit: 2165

As to claim 47, Uchio and Kossovsky teach the invention substantially as claimed. Kossovsky further teaches enabling ideas contributed to said database to be integrated within said database to thereby facilitate derivation of inventions from said integrated ideas [ab].

As to claim 83, Uchio and Kossovsky teach the invention substantially as claimed. Kossovsky further teaches that contingent economic gain includes shares of stock in a proprietor of said database or a party in concert with the database proprietor [0075; 0076; 0095; 0121].

As to claim 84, Uchio and Kossovsky teach the invention substantially as claimed. Kossovsky further teaches that step (c ) is in exchange for acquiring or facilitating transfer of at least some said property rights [0053; 0054; 450 of fig. 4].

As to claim 96, Uchio and Kossovsky teach the invention substantially as claimed. Kossovsky further teaches effecting said transfers of property rights from said contributors of problems or needs whom contribute only said problems or needs [ab; 410-450 of fig. 4].

As to claim 97, Uchio and Kossovsky teach the invention substantially as claimed. Kossovsky further teaches providing said economic gain to said contributors whom contribute only said problems or needs [450 of fig. 4].

Art Unit: 2165

As to claim 98, Uchio and Kossovsky teach the invention substantially as claimed. Kossovsky further teaches providing rights to a portion of anticipated income derived from said property rights to said contributors whom contribute only said problems or needs [0070].

As to claim 99, Uchio and Kossovsky teach the invention substantially as claimed. Kossovsky further teaches providing rights to a portion of anticipated income derived from said property rights to said contributors of said problems or needs [ab; 0005-0009; 0053; 0054; 0056-0061].

As to claim 100, Uchio and Kossovsky teach the invention substantially as claimed. Kossovsky further teaches at least some of said transfers are to a proprietor of said database or to a party in concert with said proprietor [0070].

As to claim 101, Uchio and Kossovsky teach the invention substantially as claimed. Kossovsky further teaches utilizing a computer system to establish obligations by said contributors of problems or needs to transfer said property rights [0036].

As to claim 102, Uchio and Kossovsky teach the invention substantially as claimed. Kossovsky further teaches establishing obligations by said contributors of problems or needs to transfer said property rights by utilizing a computer system that is programmed to facilitate said transfers by on-line communications with contributor computers [0036-0039].

Art Unit: 2165

As to claim 103, Uchio and Kossovsky teach the invention substantially as claimed. Kossovsky further teaches enabling ideas contributed to said database to be integrated by said contributors within said database to thereby facilitate derivation of inventions from said integrated ideas [0036-0039].

As to claim 104, Uchio and Kossovsky teach the invention substantially as claimed. Kossovsky further teaches providing access links between problem or need ideas and solution ideas received from contributors of said solution ideas [0036-0043].

As to claims 106, 108-124, 126-132, 134-137 and 139-142, all limitations of these claims have been addressed in the analysis above, and these claims are rejected on that basis.

Applicant's arguments filed on August 22, 2005 Applicant's arguments with respect to claims 35, 39, 40, 42-44, 47, 83, 84 and 95-142 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after



Art Unit: 2165


the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuy Pardo, whose telephone number is 571-272-4082. The examiner can normally be reached Monday through Thursday from 8:30 AM to 5:00 PM.

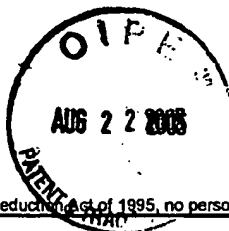
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

November 21, 2005



**THUY N. PARDO**  
**PRIMARY EXAMINER**



PTO/SB/08A (07-05)

Approved for use through 07/31/2006. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Substitute for form 1449/PTO

**INFORMATION DISCLOSURE  
STATEMENT BY APPLICANT**

(Use as many sheets as necessary)

**Complete if Known**

Application Number	09/980,654
Filing Date	October 25, 2001
First Named Inventor	SORENSEN
Art Unit	2165
Examiner Name	Thuy N PARDO
Attorney Docket Number	52-162

Sheet 1 of 1

**U. S. PATENT DOCUMENTS**

Examiner Initials*	Cite No. <sup>1</sup>	Document Number	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Number-Kind Code <sup>2</sup> (if known)			
TP		US- 2003/0036947	02/20/2003	SMITH, III et al.	
		US-			
		US-			
		US-			
		US-			
		US-			
		US-			
		US-			
		US-			
		US-			
		US-			
		US-			
		US-			
		US-			
		US-			
		US-			

**FOREIGN PATENT DOCUMENTS**

Examiner Initials*	Cite No. <sup>1</sup>	Foreign Patent Document	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages Or Relevant Figures Appear	T <sup>6</sup>
		Country Code <sup>3</sup> Number <sup>4</sup> Kind Code <sup>5</sup> (if known)				

Examiner Signature	Thuy N Pardo	Date Considered	11/21/05
-----------------------	--------------	--------------------	----------

\*EXAMINER: Initial if reference/considered whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. <sup>1</sup> Applicant's unique citation designation number (optional). <sup>2</sup> See Kinds Codes of USPTO Patent Documents at [www.uspto.gov](http://www.uspto.gov) or MPEP 901.04. <sup>3</sup> Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>4</sup> For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. <sup>5</sup> Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. <sup>6</sup> Applicant is to place a check mark here if English language translation is attached.

This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.

<b>Notice of References Cited</b>	Application/Control No. 09/980,654	Applicant(s)/Patent Under Reexamination SORENSEN ET AL.	
	Examiner Thuy Pardo	Art Unit 2165	Page 1 of 1

**U.S. PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
*	A	US-2004/0220881	11-2004	Powell, Michael D.	705/059
	B	US-			
	C	US-			
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

**FOREIGN PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

**NON-PATENT DOCUMENTS**

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

\*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)  
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

Organization

IC2100

RANDOLPH

Bldg./Room

U. S. DEPARTMENT OF COMMERCE

COMMISSIONER FOR PATENTS

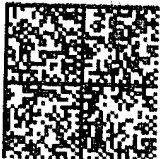
P.O. BOX 1450

ALEXANDRIA, VA 22313-1450

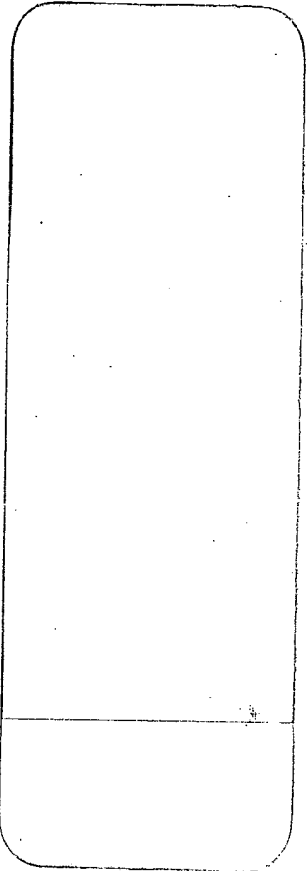
IF UNDELIVERABLE RETURN IN TEN DAYS

OFFICIAL BUSINESS

AN EQUAL OPPORTUNITY EMPLOYER



02 1A  
0004204479  
MAILED FROM



RECEIVED

DEC 5 2005

USPTO MAIL CENTI